

Notice of Allowability

Application No.

09/800,776

Examiner

Callie E. Shosho

Applicant(s)

YAMANOUCI ET AL.

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to amendment filed 7/28/03 and telephonic interview conducted 11/4/03.
2. ☒ The allowed claim(s) is/are 1,3-15 and 17-20.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
 - * Certified copies not received: _____.
5. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - (a) ☐ The translation of the foreign language provisional application has been received.
6. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. **THIS THREE-MONTH PERIOD IS NOT EXTENDABLE**

7. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
8. ☐ CORRECTED DRAWINGS must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No. _____.
 - (b) ☐ including changes required by the proposed drawing correction filed _____, which has been approved by the Examiner.
 - (c) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No. _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet.

9. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|--|---|
| 1 <input type="checkbox"/> Notice of References Cited (PTO-892) | 2 <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3 <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 4 <input checked="" type="checkbox"/> Interview Summary (PTO-413), Paper No. <u>11/4/03.</u> |
| 5 <input type="checkbox"/> Information Disclosure Statements (PTO-1449), Paper No. _____ | 6 <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 7 <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material | 8 <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9 <input type="checkbox"/> Other |

Examiner's Amendment

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

(1) Claim 4, in the line between Formula [S-8] and Formula [S-9], insert "and".

(2) Claim 4, in Formula [S-8], after "(R¹⁹)", delete the subscript "1" and insert the subscript "i".

(3) In claim 10, line 3, after (III), delete the period "." and insert ":".

(4) Claim 10, first two lines after General Formula (III), delete "wherein, R¹, R², R³, R⁴, R⁵, R⁶ and R⁷ are synonymous with R¹, R², R³, R⁴, R⁵, R⁶ and R⁷ in said formula (II);" and insert

"wherein R¹, R² and R³ are synonymous with R¹, R², and R³ in said formula (II);

R⁴ and R⁵ represent respectively independently a hydrogen atom, an aliphatic group, an aromatic group, or a heterocyclic group;

R⁶ and R⁷ represent respectively independently a hydrogen atom, a halogen atom, an aliphatic group, an aromatic group, a heterocyclic group, a cyano group, -SR⁵¹, -SR⁵², -CO₂R⁵³, -OCOR⁵⁴, -NR⁵⁵R⁵⁶, -CONR⁵⁷R⁵⁸, -SO₂R⁵⁹, -SO₂NR⁶⁰R⁶¹, -NR⁶²CONR⁶³R⁶⁴, -NR⁶⁵CO₂R⁶⁶, -COR⁶⁷, -NR⁶⁸COR⁶⁹, or NR⁷⁰SO₂R⁷¹."

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2. Authorization for this examiner's amendment was given in a telephone interview with George Lesmes on 11/4/03.

Statement of Reasons for Allowance

3. The present claims are allowable over the “closest” prior art Ishizuka et al. (U.S. 2001/0023267), Ober et al. (U.S. 4,692,188), and Meyrick et al. (U.S. 6,344,497) for the following reasons:

(a) The filing date of Ishizuka et al. lies between the filing date and the priority date of the present application as seen below:

Application No. 09/800,776 *priority date* – 3/21/00

Ishizuka et al. *filing date* – 12/21/00

Application No. 09/800,776 *filing date* – 3/8/01

Under MPEP 706.02(b), rejections based on 35 U.S.C. 102(e) can be overcome by perfecting the filing date of the priority document. Applicant’s submission of certified priority document on 3/8/01 and its English language translation on 7/28/03 results in the perfection of the foreign priority filing date. Thus, Ishizuka et al. is no longer applicable against the present claims.

(b) Ober et al. disclose water-based ink comprising oil-soluble dye and non-ionic vinyl polymer. However, there is no disclosure of specific oil-soluble dye as required in all the present claims. Further, there is no disclosure that the ink comprises hydrophobic high boiling point solvent as required in all the present claims. While Ober et al. do use solvent in a process used to

trap or entrain the dye in the polymer, the solvent is subsequently evaporated (see col.4, lines 39-41) so that the final ink composition does not contain solvent (see col.7, lines 47-58).

In order to meet the claimed limitation regarding hydrophobic high boiling point solvent, Ober et al. was combined with Meyrick et al. which is also drawn to ink jet inks and discloses the use of hydrophobic high boiling point solvent such as dibutyl phthalate. Meyrick et al. also disclose the equivalence and interchangeability between toluene as disclosed by Ober et al. and dibutyl phthalate, a hydrophobic high boiling point solvent as presently claimed.

However, as set forth above, Ober et al. requires evaporating solvent so that the final ink composition does not contain any solvent. Thus, even though Meyrick et al. provides motivation for utilizing hydrophobic high boiling point solvent, given that the ink of Ober et al. does not contain solvent, the combination of Ober et al. with Meyrick et al. does not meet the requirements of the present claims.

It is further noted that the present specification (as seen in Table 7) provides data wherein ink within the scope of the present claims, i.e. comprising hydrophobic high boiling point solvent (Ink Sets 101 and 107), is compared with ink outside the scope of the present claims, i.e. comprising no hydrophobic high boiling point solvent (Ink Sets 103 and 109). It is shown that inks of the present invention are superior in terms of printing ability and/or over-abrasion property.

Additionally, with respect to Meyrick et al., it is noted that Meyrick et al. disclose ink jet ink comprising water-dissipatable polymer, oil soluble dye, water-miscible solvent, and water-immiscible solvent, i.e. corresponding to presently claimed hydrophobic high boiling point solvent. However, there is no disclosure of specific oil-soluble dye as required in all the present

claims. Further, Meyrick et al. disclose the use of water-dissipatable polymer that is an ionic polymer, i.e. polyester bearing ionized sulfonate groups, which is in direct contrast to the present claims that require nonionic polymer.

The above is significant in light of the comparative data set forth in applicants' 1.132 declaration filed 7/28/03. The data compares inks within the scope of the present claims, i.e. comprising nonionic polymer (Ink Set 107), with inks outside the scope of the present claims but within the scope of Meyrick et al., i.e. comprising ionic polymer (Ink Set 115). It is shown that the inks of the present invention are superior in terms of humidity heat fastness.

In light of the above, it is clear that Ober et al. or Meyrick et al., either alone or in combination, do not disclose or suggest the present invention.

Thus, it is clear that the rejections of record are untenable and so, the present claims are passed to issue.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 703-305-0208. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Callie E. Shosho
Primary Examiner
Art Unit 1714

CS

11/05/03